

REMARKS

By this amendment, claims 31-36, 38-46, 48 and 49 are pending, in which claims 37, 47 and 50 are canceled, and claims 31, 36, 41, 44, 46, 48 and 49 are currently amended. The amendments to claims 31, 41 and 48 are made to incorporate the subject matter recited in now-canceled claims 37, 47 and 50. Further amendments to the claims are made to correct informalities. No new matter is introduced. Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Lam during the October 19, 2011 telephone interview in which Applicant's representative explained the deficiencies of the current rejections. Applicant's separate record of the substance of the telephone interview is incorporated into the following remarks.

The Office Action mailed August 19, 2009 objected to claims 31, 40 and 48 for various informalities.

Claims 31, 41 and 48 are amended to recite "phonebook application" to obviate this objection. Withdrawal of the objection to claims 31, 41 and 48 is respectfully requested.

The Office Action rejected claims 48-50 under 35 U.S.C. § 101 for allegedly not be directed to patentable subject matter. As discussed above, claim 50 is canceled, and thus, the rejection of claim 50 is rendered moot. The rejection of claims 48 and 49 is respectfully traversed.

Though Applicant does not believe it to be necessary, claim 48 is amended to recite "non-transitory" computer-readable storage medium to overcome this rejection. Accordingly, reconsideration and withdrawal of the rejection of claims 48 and 49 under 35 U.S.C. § 101 are respectfully requested.

The Office Action rejected claims 31-33, 35, 36, 38-43, 45, 46, 48 and 49 under 35 U.S.C. § 103(a) as obvious over *Griffin et al.* (U.S. Patent Application Publication No. 2004/0015547) in view of *Mathis* (U.S. Patent Application Publication No. 2003/0119540), claims 33 and 34 as obvious under 35 U.S.C. § 103(a) over *Mathis* in view of *Griffin et al.* and further in view of *Lopponen et al.* (U.S. Patent Application Publication No. 2002/0150091), and claims 37, 47 and 50 under 35 U.S.C. § 103(a) as obvious over *Mathis* in view of *Griffin et al.* and further in view of *Fischell et al.* (U.S. Patent No. 5,394,463). These rejections are respectfully traversed.

Independent claim 31 recites, among other features, “deleting the user selection of the one or more subscribers from the phonebook application when the ad-hoc group call ends.” Independent claims 41 and 48 recite similar features of varying scope.

Griffin et al. is directed to a system for providing chat group services to wireless mobile terminals (Abstract). The Office Action asserts *Griffin et al.* teaches many of the features recited in independent claims 31, 41 and 48. The Office Action concedes that *Griffin et al.* fails to teach the claimed storing presence information of the subscribers in the phonebook application. Rather, the Office Action relies on *Mathis*, in its disclosure of a contact list-based group call, to make up for this shortfall.

Mathis is directed to conducting a group call among communication devices based on presence information of the communication devices (Abstract). The Office Action asserts that it would have been obvious to combine *Mathis* with *Griffin et al.* to allow users to track the availability of other users easily.

Because claims 31, 41 and 48 are amended to incorporate the subject matter recited in now-canceled dependent claims 37, 47 and 50, the remainder of these remarks will be directed to the rejection of claims 37, 47 and 50.

The Office Action concedes the combination of *Mathis* with *Griffin et al.* fails to teach the claimed “deleting the user selection of the one or more subscribers from the phonebook application when the ad-hoc group call ends.” Rather, the Office Action relies on *Fischell et al.*, in its disclosure of a telephone call processing arrangement, to make up for this shortfall.

Fischell et al. is directed to a method for processing a telephone call (Abstract). The Office Action asserts *Fischell et al.* teaches features, at col. 9, lines 11-20, that can be considered to correspond to the claimed “deleting the user selection of the one or more subscribers from the phonebook application when the ad-hoc group call ends.” The Office action asserts it would have been obvious to have combined *Fischell et al.* with *Mathis* and *Griffin et al.* simply because *Fischell et al.* teaches a program that erases all information pertaining to a call from its associated memory. The analysis of the Office Action errs for at least the following reasons.

Fischell et al. cannot reasonably be relied upon to have rendered obvious the claimed “deleting the user selection of the one or more subscribers from the phonebook application when the ad-hoc group call ends.” *Fischell et al.*, at col. 9, lines 11-20, teaches that a program erases all information pertaining to a call from its associated memory. While *Fischell et al.* may teach erasing call features, *Fischell et al.* does not specifically teach deleting a user selection.

Independent claims 31, 41 and 48 similarly recite “specify, by way of a user selection via a phonebook application resident on a user device, one or more subscribers from a list stored on the user device; initiate establishment of an ad-hoc group call with the user device and one or more subscriber devices associated with the one or more subscribers.” It is unreasonable for the Office Action to assert that the claimed user selection can be considered to correspond to a call feature that is erased in *Fischell et al.* because, as recited in the claims, the recited selection is independent of the claimed ad-hoc group call. Therefore, if *Fischell et al.* indeed erases all

information pertaining to a call, because the claimed selection is not part of the call, *Fischell et al.* would not erase anything that can be considered to correspond to the claimed selection.

Further, even if *Fischell et al.* teaches the Office Action asserts, an assertion with which Applicant does not agree, MPEP § 2142 instructs that the proper standard by which to determine obviousness requires (1) that the examiner step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art,” (2) that “[i]n view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person,” and (3) that any knowledge gained from Applicant’s disclosure must be put aside at reaching this determination in order to avoid the tendency to resort to the impermissible application of hindsight reasoning based on the roadmap provided by Applicant’s disclosure. Clearly, there is nothing in *Fischell et al.*, *Mathis* and/or *Griffin et al.* to suggest that one of ordinary skill in the art at the time of Applicant’s invention may have, in any way, predictably combined *Fischell et al.* with *Mathis* and *Griffin et al.* in the manner suggested by the Office Action, and such has not been adequately shown.

Even post-*KSR*, the analysis supporting an obviousness rejection must be explicit. The Supreme Court in *KSR International Co. v. Teleflex* (citations omitted) upheld its position in *in re Kahn* (citations omitted) asserting that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. “Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” This standard is also not met here with the mere conclusory statement that one of ordinary skill in the art may have combined *Fischell et al.* with *Mathis* and *Griffin et al.* simply based on the alleged presence of such features in *Fischell et al.*, and based on reasoning clearly formulated based on the roadmap of the recited language in the pending

claims. As such, to assert that *Fischell et al.* would have been predictably combinable with *Mathis* and *Griffin et al.* can only be based on the impermissible application of hindsight reasoning.

Lastly, MPEP § 2143 is explicit in setting forth exemplary rationales to guide the obviousness analysis in supporting a rejection under 35 U.S.C. § 103. The mandate of this MPEP section is that “[t]he key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” Not only is this standard ignored, but there is not even an attempt by the Office Action to frame the asserted obviousness rejection over this combination of applied references under any exemplary rationale set for in the Patent Office’s guidance to its Examiners.

For at least the foregoing reasons, no combination of *Fischell et al.* with *Mathis* and *Griffin et al.* would have rendered obvious the combination of all of the features recited in independent claims 31, 41 and 48. Additionally, it would not have been obvious to one of ordinary skill to have combined *Fischell et al.* with *Mathis* and *Griffin et al.* in the manner the Office Action suggest. Further, and because *Lopponen et al.* does not make up for the above-identified shortfalls in the applied references and/or the Office Action’s reasoning, dependent claims 32-36, 38-40, 42-46 and 49 would also not have been rendered obvious for at least the dependence of these claims on independent claims 31, 41 and 48, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 31-36, 38-46, 48 and 49 over under 35 U.S.C. § 103(a) over the various combinations of applied references are respectfully requested.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested.

If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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